

14400
MAR 12 1989
GROUP 180

188/167

45
1-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

296
TUNB
Ex parte ANTHONY MAGLICA

Appeal No. 97-3131
Application 07/411,576

REPLY TO ORDER TO SHOW CAUSE

Serial Number: 07/411,576
Filing Date: 09/22/89
Appellant: Anthony Maglica
Examiner: M. H. Tung, A.U. 2901

Board of Patent Appeals and Interferences
Hon. Assistant Commissioner for Patents
Washington, D. C. 20231

Sirs:

This is a response to the ORDER TO SHOW CAUSE AND REMAND TO
EXAMINER mailed December 1, 1998.

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that three copies of this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Board of Patent Appeals and Interferences, Assistant Commissioner for Patents, Washington, D.C. 20231.

January 04, 1999
Date of Deposit

John D. McConaghy
Name of Person Mailing Paper

Signature of Person Mailing Paper

BACKGROUND

SEP 05 PM 4:05

APPEALS

An APPEAL BRIEF was filed in the present case on September 5, 1996.

no. 1 / Accompanying the APPEAL BRIEF was a THIRD AMENDMENT AFTER FINAL REJECTION presenting a new formal drawing with every expectation that it would comply with every requirement the Examiner had asked for and previously brought to the attention of the Applicant with the exception of the one issue of discontinuity in the head. All proportions were understood to be the same as in the original mechanical drawings. An Advisory Action was sent on November 12, 1996 entering the drawing and presenting two points asserted to be new matter. This was received by the Prosecution Department of Lyon & Lyon on November 18, 1996. An Examiner's Answer was filed on February 21, 1997.

THE REPLY

The undersigned reviewed the Examiner's Answer and specifically noted the statement under paragraph (10) *New ground of rejection* which stated "This Examiner's Answer does not contain any new ground of rejection." At the time the Examiner's Answer was received and up until the investigation undertaken to prepare this Reply, the undersigned was under the misunderstanding that there had not been any Advisory Action. The admission of the drawing presented on September 5, 1996 for purposes of appeal was thought to have been without any further objection and without any paper. There was thought to have been nothing since the Final Rejection, and that had been covered by the Appeal Brief. This was clearly not the case if one were to carefully read

RECEIVED
SEP 05 PM 4:05
SEP 05 PM 4:05

the Examiner's Answer. However, the error in what one understands to be the state of affairs is often difficult to discover.

The file, because of its very large size, had been divided in two and various papers were filed out of chronological order in one file rather than the other. The Advisory Action, however, was not placed in either file. The normally generated second copy and routing slip prepared by the prosecution clerical department were still attached thereto and the assembly was found in the folder of miscellaneous papers associated with this application. The undersigned believes that he did not see this Advisory Action, certainly does not remember the Advisory Action and did not act as if he was aware of the Advisory Action as of the time of filing a Response to the Examiner's Answer. He never became disabused of his misunderstanding of the facts. Taking the statement that "no new issues were presented" from the Examiner's Answer, no reply was prepared.

PRACTICAL EFFECT

This application was filed in 1989. Among other things, it has most recently been lost at the Board of Appeals for a long period of time. It is hoped that the Applicant does not have to start over, given the very long periods which the Applicant has experienced, in an effort to gain final hearing and allowance of the above application. The failure to recognize new issues and the failure to file a Reply were based upon the unintentional misunderstanding of the undersigned. Reconsideration is requested on the Order to Show Cause. Further, if reconsideration would require a request to suspend the rules

or other petition to avoid further inequity, such is made by this Reply and any fees required may be charged to Deposit Account No. 12-2475.

FIRST NEW REJECTION

The Examiner indicated that the smooth portion of the barrel between the threaded end (bulb end) and the knurled barrel is proportionally longer than shown in the original formal and the original mechanical drawings. To resolve this, the correct drawing and figure must be considered. The present application was filed with the mechanical drawings under Rule 60. The application was amended by canceling the entire specification and the drawings and preparing a new design application and an appropriate drawing therefor. Consequently, the original drawings in the present application are the mechanical drawings which were copied from prior applications. It is understood that it is against these drawings which one must compare the propriety of the current formal drawing. Figure 8 is the appropriate Figure to consider because the head covers over a portion of the smooth barrel when the head is in place over the bulb end of the barrel as seen in Figure 1. Only Figure 8 shows the full extent of the barrel at the bulb end which is also shown in the design drawing in the present application.

The undersigned has attempted to investigate the issue of the proper proportion of this portion of the barrel and believes that the space between the threaded end and the knurling is proportional to what is shown in the original mechanical drawings in Figure 8. To accomplish the foregoing comparison, the undersigned made a copy of Figure 2 of the formal drawings submitted September 5, 1996 and a copy of the original Figure 8 of the mechanical drawings. An arc equal to the length of the

exposed barrel between the head and the threaded bulb end was constructed from the intersection of the head and the barrel on the new formal drawing. At a point of tangency between the previously constructed arc and a line extending from the barrel at the threaded bulb end a line was drawn from the intersection of the head with the barrel to that point of tangency. The copy of the mechanical drawing of Figure 8 was then superimposed at that position and parallel lines drawn between the two figures for comparison of ratios. The intersection of these lines with the ends of the knurling show that the ratio is the same between overall length of that barrel and the smooth portion at issue for both the original mechanical drawing of Figure 8 and the current formal drawing. A copy of the construction described above is attached.

With a showing that the proportions are identical, and that Figure 8 is the appropriate drawing to consider, applicant believes that the rejection is inappropriate. Reconsideration is requested.

SECOND NEW REJECTION

A second issue was raised regarding the spacing of the outermost and next inwardly concentric lines illustrated in Figure 3. The lines were rejected as being spaced too far apart and, therefore, new matter. The outermost line represents the maximum diameter of the head. The next line in is the outer edge of the machined surface on the back end of the head. These are believed to be drawn proportionally consistent with the mechanical drawings. The same technique was employed to construct a proportional comparison with Figure 2 of the original mechanical drawings. Figure 2 was picked as it provided the best measure of the two dimensions. As best as

it can be determined, the proportion is correct. A copy of the construction described above is attached. Figure 3 agrees with the other figures in the formal drawing as well, which were not objected to in this respect.

Again, the figures are correct to the best of applicant's ability as measured from the original mechanical drawings. Reconsideration is requested.

CONCLUSION

The failure to file a Reply where new issues were raised was the result of an unintentional misunderstanding that no new issues had been raised based on the statement in the Examiner's Answer and the lack of awareness of the Advisory Action. The hardship from the imposition of further delay with a new application is obvious.

The substantive issues present a quandary. There is no effort to try to make the design look better or different. Exact proportions have been slavishly attempted. To acquiesce to incorrect changes after these details have been emphasized through rejection would draw any patent issuing from the application into question. The proportions in the Figures have been graphically analyzed and are believed correct. There is no motivation to argue otherwise. Reconsideration is requested.

Respectfully submitted,

LYON & LYON LLP

By

John D. McConaghy
Reg. No. 26,773

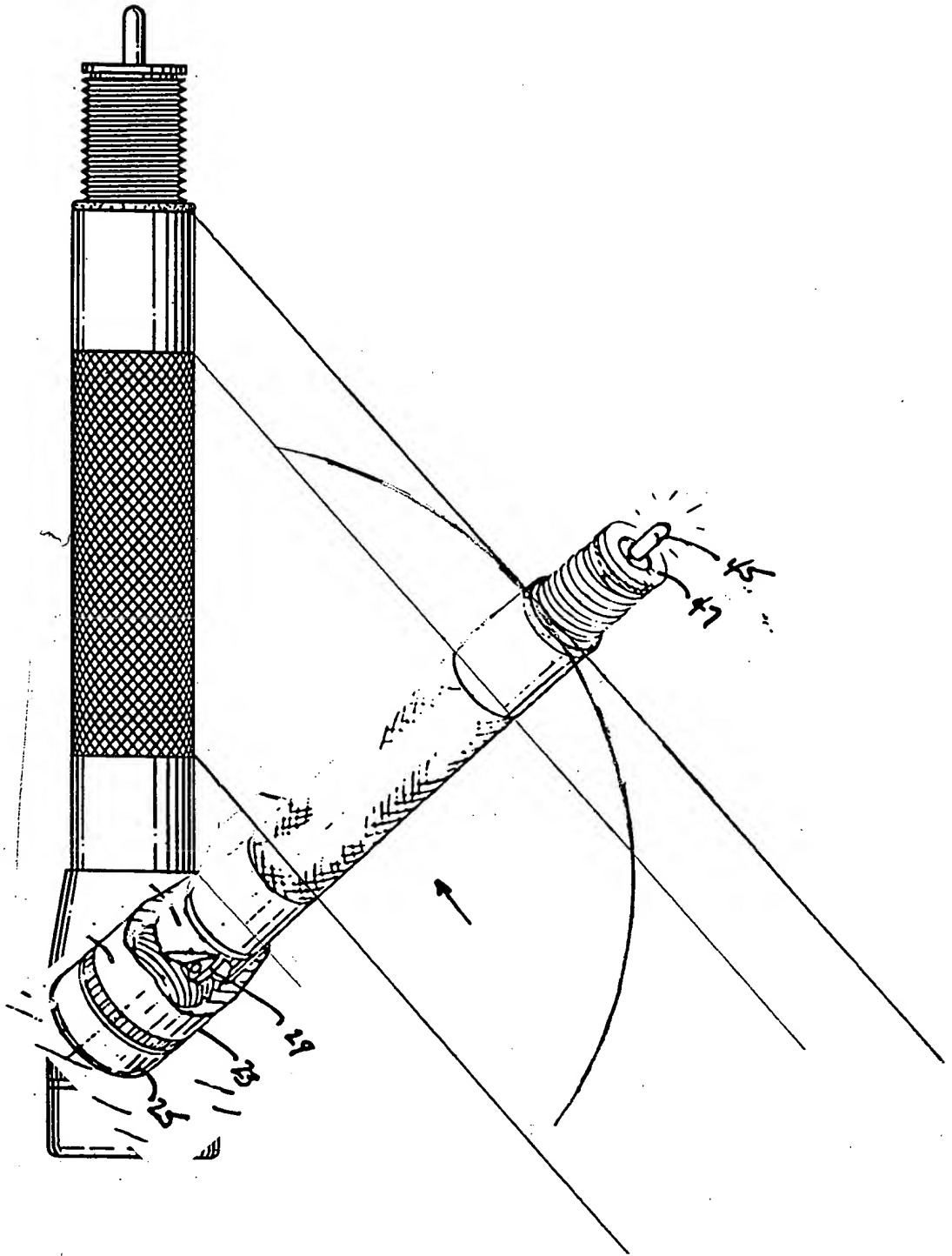
January 4, 1999

47th Floor
633 West Fifth Street
Los Angeles, CA 90071-2066
(213) 489-1600

BEST AVAILABLE COPY

Magica
Appeal No. 97-3131
Application 07/411576

BEST AVAILABLE COPY



Maglica
Appeal No. 97-3131
Application 07/41,574

